UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,490	09/12/2000	Tadahiro Aihara	04329.2392	6306

22852 7590 12/20/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER	
FLANDERS, ANDREW C	

ART UNIT	PAPER NUMBER
2644	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/660,490	AIHARA ET AL.	
	Examiner	Art Unit	
	Andrew C Flanders	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9-16 and 25-32* is/are allowed.

6)☒ Claim(s) *1-8 and 17-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 – 8 and 17 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows (U.S. Patent 6,377,530) in view of Terui (U.S. Patent 5,903,871).

3. Regarding Claims 1 and 17, Burrows discloses a jack for coupling the system to a computer for downloading compressed audio data onto the hard disk (col. 4 lines 22 – 24) (i.e. means for recording a content supplied from an external device) audio output jack (Fig. 1 ref. 130) (i.e. means for reproducing the content). Burrows does not disclose means for detecting that said reproducing means performs a reproduction when a recording command is issued or means for disabling said reproducing means and enabling said recording means when said detecting means detects that said reproducing means performs the reproduction. Terui discloses a voice reproducing apparatus with a method of determining whether recording is on (Fig. 12 S38) or playing is on (Fig. 12 S40) (i.e. means for detecting that said reproducing means performs a reproduction when a recording command is issued or means for disabling said reproducing means and enabling said recording means when said detecting means detects that said reproducing means performs the reproduction). One of ordinary skill in

the art at the time of the invention would have been motivated to use Terui's detection method on Burrows audio system in order to facilitate recording and file transfers. It is desirable to avoid corrupted data and data loss and by monitoring when recording is to be done, this can be eliminated.

4. Regarding Claims 2 and 18, in addition to the elements stated above regarding claims 1 and 17, Terui discloses a voice reproducing apparatus with a method of determining whether recording is on (Fig. 12 S38) or playing is on (Fig. 12 S40) (i.e. means for enabling said recording means when said detecting means does not detect that said reproducing means performs reproduction).

5. Regarding Claims 3 and 19, in addition to the elements stated above regarding claims 1 and 17, Terui discloses a voice reproducing apparatus with a method of determining whether recording is on (Fig. 12 S38) (i.e. second detecting means for detecting that said recording means is turned on when the recording command is issued, and means for turning on said recording means when said second detecting means does not detect that said recording means is turned on).

6. Regarding Claims 4 and 20, in addition to the elements stated above regarding claims 1 and 17, Terui discloses that if rec isn't on and play is, voice reproduction continues (Fig. 12 S38 and S40) (i.e. means for restarting interrupted reproduction after recording is completed).

7. Regarding Claims 5 and 21, Burrows discloses a jack for coupling the system to a computer for downloading compressed audio data onto the hard disk (col. 4 lines 22 – 24) (i.e. means for recording a content supplied from an external device) audio output

jack (Fig. 1 ref. 130) (i.e. means for reproducing the content) and the host computer, when coupled to the system via the jack, can access the table of contents, delete entire CDs and/or tracks stored on the hard disk, download additional CDs and/or tracks onto the hard disk, and replace or update the table of contents (i.e. means for detecting that the apparatus is connected to the external device). Burrows does not disclose setting an operation mode and means for controlling said recording means and said reproducing means in accordance with the operation mode when said detecting means detects that the apparatus is connected to the external device. Terui discloses multiple playback control buttons (Fig. 1 element 19) (i.e. means for setting an operation mode) and a method of determining whether recording is on (Fig. 12 S38) or playing is on (Fig. 12 S40) (i.e. and means for controlling said recording means and said reproducing means in accordance with the operation mode when said detecting means detects that the apparatus is connected to the external device). Motivation to combine these devices is given above regarding claim 1.

8. Regarding Claims 6 and 22, in addition to the elements stated above regarding claim 5, Burrows discloses a jack for coupling the system to a computer for downloading compressed audio data onto the hard disk (col. 4 lines 22 – 24) (i.e. connected to an external apparatus). Terui discloses a check to see if play is on (Fig. 12 S40) (i.e. first mode, reproduction is continued), a check to see if rec is on (Fig. 12 S38) (i.e. second mode, reproduction is stopped and recording is started and third mode, recording is started after reproduction is completed and fourth mode, reproduction is interrupted and recording is started and after recording, the interrupted reproduction is restarted).

9. Regarding Claims 7 and 23, in addition to the elements stated above regarding claims 6 and 22, Terui discloses multiple manual playback control buttons (Fig. 1 element 19) (i.e. setting means comprises an interface device for manually presetting the operation mode).

10. Regarding Claims 8 and 24, in addition to the elements stated above regarding claims 5 and 21, Burrows further discloses the host computer, when coupled to the system via the jack, can access the table of contents, delete entire CDs and/or tracks stored on the hard disk, download additional CDs and/or tracks onto the hard disk, and replace or update the table of contents (i.e. setting means comprises means for receiving a mode setting command from the external device).

Allowable Subject Matter

11. Claim 9 - 16 and 25 - 32 are allowed.

12. Regarding Claims 9 and 25, Burrows discloses a jack for coupling the system to a computer for downloading compressed audio data onto the hard disk (col. 4 lines 22 – 24) (i.e. means for recording a content supplied from an external device) and audio output jack (Fig. 1 ref. 130) (i.e. means for reproducing the content). Terui discloses an input/output buffer (Fig. 1 element 7) (i.e. the reproducing means buffering content data before reproduction) and a check to see if play is on (Fig. 12 S40), a check to see if rec is on (Fig. 12 S38). Burrows further discloses a predefined amount of compressed audio data from the disk storage unit or the volatile memory buffer is placed into the non-volatile memory buffer when the portable audio player is commanded to stop playing (col. 2 lines 64 – 67). Neither Burrows nor Terui disclose or make obvious

checking a buffer to ensure it has a sufficient amount of data available to resume playback after recording has completed. Burrows discusses placing a predetermined amount of audio data into a volatile memory buffer when the unit receives a stop command but it does not teach enabling a recording means when a sufficient amount of content is buffered. Therefore Claim 9 and 25 are allowable.

13. Claims 10 – 16 and 26 – 32 are allowable based upon their dependence from an allowable claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C Flanders whose telephone number is (703) 305-0381. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forrester Isen can be reached on (703) 305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

acf

FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER